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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,448	06/04/2001	Patrick Midoux	USB98ASIDM	3117
466	7590	11/06/2003	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			SCHNIZER, RICHARD A	
			ART UNIT	PAPER NUMBER

1635

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/857,448

Applicant(s)

MIDOUX ET AL.

Examiner

Richard Schnizer, Ph. D

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-14, 17 and 19.

Claim(s) withdrawn from consideration: 15, 16, 18.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 2. NOTE: As a preliminary matter, it is noted that any amendment that renders the claims definite would not be enterable because it would necessitate new search due to the fact that no meaningful search has been carried out to date because of the indefiniteness of the claims. In any case, the proposed amendment is also not enterable for the following reasons. The proposed amendment to claim 6 eliminates the definition of the term "u", which is not defined elsewhere except as a numerical value. It is unclear to what parameter "u" refers, so all claims reciting "u" are indefinite. In claim 8, the phrase "corresponding to the formula  $R = [\text{structure}]$ " is confusing because "R" was defined immediately above this expression as another different structure. What does Applicant intend by "corresponding to"? Claim 14 remains indefinite because it is unclear to what the antisense oligonucleotide is intended to bind in the second paragraph of the claim. Claim 14 is also indefinite because it is unclear what is intended by a "corresponding gene of a second messenger". Is this a gene activated by a second messenger, or a gene encoding a second messenger? It is noted that Applicant has not indicated where in the specification support may be found for the amendment to the third paragraph of claim 14. It remains unclear what are the metes and bounds of "corresponding to a repetitive bacterial type DNA sequence" for several reasons. The meaning of "corresponding" is unclear. Does Applicant intend "complementary to"? It is unclear what are the metes and bounds of "a bacterial type sequence". What is "bacterial type DNA"? How is it distinguished from any other immunostimulating sequence? The amendment of claim 14, paragraph 6, changes the method completely. It is now a method of transferring oligonucleotides wherein transfer is accomplished by blocking the binding of regulatory factors to a specific DNA region. It is unclear how this method is intended to function. Is the "specific DNA region" a part of the oligonucleotide, or is it a region of chromosomal DNA encoding a factor that increases uptake of oligonucleotides? Claim 19 as amended would be indefinite because "the biological molecules to be transferred" is recited without proper antecedent basis. It is suggested that part 'c' should be rewritten as "reagents enabling transfer of biological molecules into the cell" or "reagents enabling transfer of the at least one biological molecule into the cell."

Continuation of 5. does NOT place the application in condition for allowance because: The amendment could not be entered for the reasons given above. Even if "u" was defined, its meaning in e.g. claim 8 would remain unclear. For example "(u)" appears in claim 8 immediately after the expression " $i = 19 \quad n = 4$ " and before a definition of "R". It is unclear what this contributes to the claim. Applicant asserts at page 30 of the response that "u" is an absolute number. What is the purpose of inserting an absolute number between these expressions? Is it somehow associated with one or the other of them? If so, then how? Applicant's explanation of "i minus 2" in claim 6 is appreciated, and the Examiner agrees that this should be clear to one of ordinary skill in the art. The arithmetic functions in claim 7 remain indefinite because the definition of "u" is unclear.



DAVE T. NGUYEN  
PRIMARY EXAMINER